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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,132	05/31/2007	Stefan Trumpi	BR P1003 US	1392

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THADDIUS J. CARVIS
102 NORTH KING STREET
LEESBURG, VA 20176

EXAMINER

MAYO-PINNOCK, TARA LEIGH

ART UNIT	PAPER NUMBER
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3671

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,132	Applicant(s) TRUMPI, STEFAN	
	Examiner TARA MAYO-PINNOCK	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3.5,6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3.5,6 and 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 December 2010 has been entered.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

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- (I) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A “Sequence Listing” is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required “Sequence Listing” is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities: omitted section headings and non-idiomatic English. Appropriate correction is required.

Claim Objections

3. Claims 5, 6 and 8 through 11 are objected to because of the following informalities: non-idiomatic English and a minor grammatical error.

With specific regard to claim 5, change “sections” to --section-- on line 3.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 through 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 8, the scope of the claimed invention is indefinite because it is unclear if “an expansion element” is related to the previously recited expansion element of claim 13 or 14.

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With regard to claim 9, the scope of the claimed invention is indefinite because variable K_1 and K_2 are not defined.

Claim 10 recites the limitation "in pressing shaft" on line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 5, 6 and 8 through 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson (U.S. Patent No. 4,432,667 A) in view of Uemura (U.S. Patent No. 4,095,435 A).

Richardson '667 discloses a method for determining/controlling the propulsion force on a plurality of pipe elements (12-n) to produce a longitudinal structure (10) in the earth using a pressing device (i.e., hydraulic rams 60) and deformable fluid-filled expansion elements (22-n) arranged in joints of the pipe elements, the longitudinal structure including a header piece (12-1) controlled with a front expansion element (22-1); wherein the method includes the steps of filling the expansion elements with a pressure-resistant fluid (col. 7, lines 32 through 35) and measuring the fluid pressure in the expansion element (col. 4 at lines 52 through 67); wherein the expansion

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elements have circular cross sections; wherein use of the expansion elements inherently controls the installation of the pipe elements and affects the quality of the installation.

Richardson '667 does not expressly teach the steps of measuring a deformation of the joint by at least three local expansion measurements and calculating geometric data of an expansion plane of the joint from the three local measurements.

Uemura '435 discloses a method of advancing a plurality of construction units having joints therebetween, the method comprising the step of measuring deformation of the joints by three measurements (i.e., those measurements taken by the split-measuring, vertical shift-measuring and horizontal shift-measuring instruments per Claim 9) and, inherently, calculating geometric data of an expansion plane of the joint from the three local measurements, the steps being useful for the remote control of the propulsion of the units.

With regard to claims 13 and 14, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the method of Richardson '667 such that it would further include the steps of measuring a deformation of the joint by at least three local expansion measurements and calculating geometric data of an expansion plane of the joint from the three local measurements as taught by Uemura '435. Specifically, one having ordinary skill in the art would have had a reasonable expectation of success since the modification would have merely required the addition of known steps to yield predictable results.

With specific regard to claim 5, the combination of Richardson '667 and Uemura '435 fails to teach the expansion element divided into sections, each section being individually

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measured and having its own fluid supply. It would have been obvious to one having ordinary skill in the art at the time of invention to divide the expansion element into sections, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, it would have been obvious to one having ordinary skill in the art at the time of invention to individually measure the pressure of each section and provide each section with its own fluid supply, since it has been held that mere duplication of the essential steps/working parts of a method/device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With specific regard to claim 9, Richardson '667 does not teach use of an alarm. However, it would have been obvious to one having ordinary skill in the art at the time of invention to modify the prior art method such that it would include an alarm to monitor and indicate potential failure due to exceeded force limits, since the examiner takes Official Notice of the use of such alarms extensively in the art of pipe laying.

Response to Arguments

8. Applicant's arguments with respect to claims 3, 5, 6 and 8 through 14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TARA MAYO-PINNOCK whose telephone number is (571) 272-6992. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TARA MAYO-PINNOCK/
Primary Examiner, Art Unit 3671

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03 January 2011